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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,853	11/02/2001	Ashok V. Joshi	4729US	7449
55162	7590	03/23/2006		EXAMINER
CERAMATEC, INC. 2425 SOUTH 900 WEST SALT LAKE CITY, UT 84119				DESANTO, MATTHEW F
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/003,853	JOSHI, ASHOK V.
	Examiner Matthew F. DeSanto	Art Unit 3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 December 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21,23,25-35 and 37 is/are rejected.
- 7) Claim(s) 24 and 36 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1-11, 13, 17-21, 23, and 25-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts et al. (USPN 6,001,088)

Roberts et al. teaches an iontophoresis method and apparatus for opthamalic delivery of a beneficial agent comprising two electrodes (10, 11), connected to a power source (12), and both configured to contain the beneficial agent that is to be delivered subcutaneously to the patient. The electrode has semi-permeable membrane (column 4, line 64) that contact with an ionic fluid of the patient. Contact of the membranes with the subject's tissue completes the circuit of the device.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. as applied to claims above, and further in view of Haak et al. (USPN 5,445,606)

Robert et al., as described above, teaches a device for eye delivery of a beneficial agent comprising two electrodes, but fails to teach a control circuit.

Haak et al. teaches a device for the delivery of a medicament comprising two electrodes with semi-permeable membranes and agent reservoirs and a battery and control circuit (31) connected to both electrodes.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine the invention of Roberts et al. with the teachings of Haak et al. because Haak et al. includes a control circuit connected between the electrodes in order to control the amount of current delivered to them, thus affecting the rate of drug delivery for a more effective treatment.

5. Claims 14-16, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. as applied to the claims above, and further in view of Theeuwes et al. (EP 0 931 564).

Roberts, as described above, teaches a device for eye delivery of a beneficial agent comprising two electrodes, but fails to teach the material of the electrodes.

Theeuwes et al. teaches an iontophoretic agent delivery device comprising carbon or titanium electrodes (column 8, lines 12- 13).

It would have been obvious to one skilled in the art at the time of the invention to use a carbon electrode, as such is standard in the art.

***Allowable Subject Matter***

6. Claims 24, 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed 12/27/05 have been fully considered but they are not persuasive.

8. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

9. The examiner is unsure what the definition the applicant is using for electronegative and electropositive. By looking at the claim language there is no specific definition given for electronegative and electropositive, therefore the broadest reasonable interpretation is given. The examiner's interpretation is that metal has the ability to be electro active and has the ability to release or accept electrons thus making the metal electronegative or electropositive depending on whether electrons are received or released. The examiner is confused because the applicant never fully discloses the definition of electropositive and electronegative, but this is moot because the definitions of electropositive and electronegative need to be incorporated into the claim in order for the specific definition to be given any patentable weight.

10. After reading through the non-patented literature, it seems that my interpretation of metals being electro active and more specifically electropositive or electronegative seems feasible since "metal-wikipedia" states that metals are conductive because of their loosely held valence electron thus allowing the metals to undergo "redox" reactions and thus making the metal electro active (electronegative/electropositive).

11. The examiner suggests adding the specific electronegative or electropositive material into the claim since this seems to be the critical feature of the invention and would distinguish the claim over the prior art and the use of metal as an ion.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew DeSanto  
Art Unit 3763  
March 19, 2006

  
Matthew DeSanto